

PATENT
ATTORNEY DOCKET NO. 50393/004001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Teumer et al.	Confirmation No.:	5032
Serial No.:	10/534,428	Art Unit:	1657
Filed:	May 10, 2005	Examiner:	Tiffany Maureen Gough
Customer No.:	21559		
Title:	CULTIVATION OF HAIR INDUCTIVE CELLS		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Applicants respectfully request withdrawal of finality of the Office Action issued in connection with the above-referenced application on April 20, 2007.

Under M.P.E.P. § 706.07, “the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.” This section also states that the “applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application.” The M.P.E.P. § 706.07(d) also states that “If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” Finally, the M.P.E.P. § 706.07(e) states “The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are

cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application.” The M.P.E.P. § 706.07(d) also states that “If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” Finally, the M.P.E.P. § 706.07(e) states “The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn.”

The facts of the case are as follows. On August 22, 2006, the Office issued a non-final action rejecting claims 16 and 29-31 for indefiniteness, claims 1, 7-10, 13, 17, and 19 for anticipation by WO 99/01034, claims 1-15, 17, 19-21, 29, and 32 for obviousness over WO 99/01034, WO 0069499, Keller et al. (*Frontiers in Bioscience*, 1996; hereinafter “Keller”), Hibberts et al. (*Journal of Endocrinology*, 1998; hereinafter “Hibberts”), and Van Nispen (U.S. Patent No. 5,002,881; hereinafter “Van Nispen”), and claims 1, 18, and 33 for obviousness over WO 99/01034. In reply on January 22, 2007, Applicants narrowed independent claim 1 to recite that the culture medium is conditioned by prostate epithelial cells.

Applicants’ amendments and arguments were sufficient to remove the indefiniteness and anticipation rejections. Nonetheless, the Office issued an Office Action on April 20, 2007, and designated it Final. Pending claims 1, 7-21, and 29-33 continued to be rejected for obviousness over the combination of WO 99/01034, WO 0069499, Keller, Hibberts, and Van Nispen for the

same reasons given in the prior non-final Office Action. The Office has stated that the reason for making the Office Action final is that “Applicant’s amendment necessitated the … rejection.”

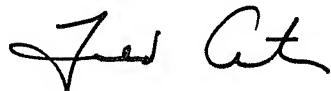
Applicants submit that finality was premature in this case. It appears that the Office did not thoroughly consider Applicants’ amendment to claim 1 and Applicants’ remarks distinguishing claims 1, 7-21, and 29-33, as amended, over the cited references. For this reason, Applicants respectfully request withdrawal of finality of the present Office Action to allow Applicants a fair opportunity to respond to the new ground of rejection, which rejection Applicants believe is thoroughly overcome by the prior amendment to claim 1 and by the arguments of record showing the differences between the claimed invention and the disclosures of the cited publications.

Applicants should not be prematurely cut off from prosecution while seeking the patent protection to which it is justly entitled. In this case, the Office rejected Applicants’ arguments provided in reply to the non-final Office Action without thoroughly considering their merit and, Applicants’ suspect, without fully appreciating the limitations of the cited references. Applicants believe that any misunderstanding of the cited references by the Examiner was rectified during a telephonic interview conducted on September 5, 2007. In view of these changed circumstances, Applicants are entitled to a full consideration of the arguments via a full Office action, as well as one further opportunity to present additional arguments and evidence to develop a clear issue prior to any appeal.

For these reasons, Applicants respectfully request withdrawal of finality.

If there are any charges or any credits, kindly apply them to Deposit Account No. 03-2095.

Respectfully submitted,



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Date: 20 September 2007

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